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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,964	03/26/2004	Jayanta Kumar Dey	99-851CON1	9817

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EXAMINER	
NGUYEN, CHAU T	

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/810,964	DEY ET AL.	
	Examiner	Art Unit	
	Chau Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *06/28/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Amendment filed on 06/19/2006 has been entered. Claims 1-26 are presented for examination.

Double Patenting

2. Claims 1, 3-8, 11-14, 16-21, and 24-26 of the instant application is unpatentable under the judicially created doctrine of "obviousness-type" double patenting with respect to claims 1-8, 10-19 and 21-22 of parent U.S. Patent No. 6,757,866.

3. Application claims 1, 3-8, 11-14, 16-21, and 24-26 define an obvious variation of the invention claimed in US Patent No. 6,757,866.

4. Claims 1, 3-8, 11-14, 16-21, and 24-26 of the instant application is anticipated by patent claims 1-8, 10-19 and 21-22 (U.S. Patent No. 6,757,866) in that claims 1-8, 10-19 and 21-22 contain all the limitations of claims 1, 3-8, 11-14, 16-21, and 24-26 of the instant application. Claims 1, 3-8, 11-14, 16-21, and 24-26 of the instant application therefore are not patently distinct from the earlier patent claims and as such are unpatentable for obvious-type double patenting.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-3, 5-16 and 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wistendahl et al. (Wistendahl), US Patent Number 5,708,845 and further in view of Barr et al. (Barr), US Patent Number 5,873,076.

7. As to independent claims 1 and 14, Wistendahl discloses a method for finding documents which relate to a portion of a temporal document, comprising:

(a) in response to a signal of interest at a particular time during the temporal document, identifying a portion of the temporal document for which related documents are to be found (Wistendahl et al., col. 2, lines 41-58, col. 3, lines 38-48, and col. 7, lines 55-59, and col. 8, lines 38-67: as the movie runs, the user can point the remote control pointer to a designated actor or object appearing on the television display and click on the desired object);

(b) selecting text associated with the portion of the temporal document identified (col. 7, lines 49-63 and col. 8, lines 38-65: user clicking on the movie "The Maltese Falcon");

However, Wistendahl do not teach (c) finding the related documents by use of information retrieval techniques as applied to the selected text, wherein the related documents are selected from a collection of documents according to scores associated with the documents, said scores based on a ratio between the number of documents in the collection and, for a term in the selected text, the number of documents in the collection containing the term. In the same field of endeavor, Barr et al. disclose a searching/retrieval system which can query a library or database and identify not only text documents, but also multi-media files stored on the library or database that are relevant to query (col. 2, line 59 – col. 3, line 54). Barr et al. also disclose accepting a query and returning a single search results list having both text and multi-media information (temporal document), and query server performs a relevance ranking on each of the textual documents and multi-media files identified by the search by generating a relevance score corresponding to each of the entries on the search result list, and this relevance is based on the term location information contained in index database, and in part on the relative proximity within the document file of terms forming the search query (col. 12, lines 54-65, col. 13, lines 30-67 and col. 24, lines 19-26). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Wistendahl and Barr to include finding the related documents by use of information retrieval techniques as applied to the selected text, wherein the related documents are selected from a collection of documents according to scores associated with the documents, said scores based on a ratio between the number of documents in the collection and, for a term in the selected

text, and number of documents in the collection containing the term. Barr suggests that assigning scores associated with documents identified during a query search would indicate the degree to which the document relates to the subject.

8. As to dependent claims 2 and 15, Wistendahl and Barr disclose wherein the temporal document is video or audio material (Wistendahl, col. 7, lines 49-63).

9. As to dependent claims 3 and 16, Wistendahl and Barr disclose wherein the video material is stored on a video server inasmuch as this element is inherent in the teaching of large digital libraries transmitted to subscribers. (Wistendahl et al., col. 6, line 58, col. 7, line 6.)

10. As to dependent claims 5 and 18, Wistendahl and Barr disclose wherein the selected text is the closed-captioned text associated with the portion of the temporal document identified (Wistendahl et al., col. 7, lines 55-59: the selected text is pop-up movie trivia, which is the equivalent of close-captioned text.)

11. As to dependent claims 6 and 19, Wistendahl and Barr disclose the temporal document including text as discussed above regarding claims 5 and 18.

12. As to dependent claims 7 and 20, Wistendahl and Barr disclose wherein the document text appearing to the user varies with time and the selected text is that portion of the temporal document identified (Wistendahl et al., col. 7, lines 53-59).

13. As to dependent claims 8 and 21, Wistendahl and Barr disclose wherein the document text includes news bulletins, weather, sports scores or stock transaction or pricing information (Barr et al., col. 31, line 43 – col. 32, line 21).

14. As to dependent claims 9 and 22, Wistendahl and Barr disclose wherein the related documents are accessed through the Internet (Wistendahl et al., col. 5, lines 14-15. and Barr et al., col. 8, line 50 – col. 9, line 22).

15. As to dependent claims 10 and 23, Wistendahl and Barr disclose further including selecting the related documents from among a collection of documents which may be accessed through the Internet, by utilizing databases comprising information about the collection (Wistendahl et al., col. 5, lines 14-15; col. 8, lines 66-67 and Barr et al., col. 8, line 50 – col. 9, line 22).

16. As to dependent claims 11 and 24, Wistendahl and Barr do not teach, but it would have been obvious to one of ordinary skill in the art to implement, selecting a predetermined number of documents, 1000, because it was well known in the art to limit search results to a predetermined number and one of ordinary skill in the art would have

recognized that this provided the benefit of not overwhelming the user, and moreover would have recognized that 1,000 documents was an upper limit of the number of documents that could comfortably be retrieved.

17. As to dependent claims 12 and 25, Wistendahl and Barr disclose wherein evaluating documents in the collection includes accessing compressed document surrogates (Barr et al., col. 14, lines 29-51 and col. 28, lines 13-37).

18. As to dependent claims 13 and 26, Wistendahl and Barr disclose wherein related documents are selected from the collection by a server which is distinct from the server which receives the signal of interest (Barr et al., col. 8, line 50 – col. 9, line 22: session server 114 for receiving a search query from user and server 116 for sending sear results information).

19. Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as al. (Barr), US Patent Number 5,873,076 as discussed in claims 1-3, 5-16 and 18-26 above, and further in view of Witteman, US Patent Number 6,243,676.

20. As to dependent claims 4 and 17, Wistendahl and Barr, however, do not explicitly disclose wherein the selected text is determined by application of speech recognition techniques to the audio component of the portion of the temporal document identified. Witteman discloses when a word or phrase (text) has been identified, the word or

phrase is sent to the speech recognizer to search recent audio feeds for that word or phrase (Abstract and col. 4, lines 49-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings Witteman Wistendahl, Barr to include the selected text is determined by application of speech recognition techniques to the audio component of the portion of the temporal document identified. Witteman's system provides text feed which is searchable and aligned with the audio feed so the user can search for the item of interest and can either read the text feed or listen to the audio feed.

Response to Arguments

In the remarks, Applicant argued in substance that

A) Barr does not teach or suggest relevance scores based on a ratio between the number of documents in the collection.

In reply to argument A, Barr discloses in col. 12, lines 54-65, col. 13, lines 30-67 and col. 24, lines 19-26 that the output relevance scores are normalized, and the normalized relevance scores are corresponding to document identification numbers corresponding to document files. It would have been obvious to one of ordinary skill in the art at the time the invention was made to acknowledge that the output relevance scores are based on the document files.

B) Barr is silent with regard to obtaining, determining, or otherwise knowing the number of documents in a collection that contain a term from the selected text.

In reply to argument B, applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., obtaining, determining) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, Barr discloses a searching/retrieval system which can query a library or database and identify not only text documents, but also multi-media files stored on the library or database that are relevant to query (col. 2, line 59 – col. 3, line 54). By identifying text documents and multi-media files stored in the library/database that are relevant to query, it would have been obvious to one of ordinary skill in the art at the time the invention was made to acknowledge that the searching/retrieval system would know what text documents and multi-media files stored in the library/database to collect or obtain in order to find relevant data or information based on the query submitted.

C) A prima facie case of obviousness is not established.

In reply to argument C, to establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine reference teachings. In this case, Wistendahl discloses the user can point the remote control pointer to a designated actor or object appearing on the television display and click on the desired object, which is similar to identifying and retrieving multi-media or text related to a search topic from a database of Barr, thus it would have been obvious in the knowledge generally available to one of ordinary skill in the art at the time the invention was made to modify or combine the teaching of Wistendahl and Barr since they both are from the same field of endeavor. The motivation for doing so is that Barr suggests that assigning scores associated with documents identified during a query search would indicate the degree to which the document relates to the subject.

Second, there must be a reasonable expectation of success. The prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, claimed invention directed to a method for finding documents which relate to a portion of a temporal document was rejected as obvious over Wistendahl which taught in col. 2, lines 41-58, col. 3, lines 38-48, and col. 7, lines 55-59, and col. 8, lines 38-67: as the movie runs, the user can point the remote control pointer to a designated actor or object appearing on the television display and click on the desired object, and further in view of Barr which taught a searching/retrieval system which can query a library or database and identify not only text documents, but also multi-media files stored on the library or database that are relevant to query (col. 2, line

59 – col. 3, line 54). Thus, there was reasonable expectation that a process combining the prior art steps could be successfully scaled up.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. In this case, Wistendahl and Barr disclose

(a) in response to a signal of interest at a particular time during the temporal document, identifying a portion of the temporal document for which related documents are to be found (Wistendahl, col. 2, lines 41-58, col. 3, lines 38-48, and col. 7, lines 55-59, and col. 8, lines 38-67: as the movie runs, the user can point the remote control pointer to a designated actor or object appearing on the television display and click on the desired object);

(b) selecting text associated with the portion of the temporal document identified (Wistendahl, col. 7, lines 49-63 and col. 8, lines 38-65: user clicking on the movie "The Maltese Falcon");

(c) finding the related documents by use of information retrieval techniques as applied to the selected text, wherein the related documents are selected from a collection of documents according to scores associated with the documents, said scores based on a ratio between the number of documents in the collection and, for a term in the selected text, the number of documents in the collection containing the term (Barr disclose a searching/retrieval system which can query a library or database and identify not only text documents, but also multi-media files stored on the library or database that are relevant to query (col. 2, line 59 – col. 3, line 54). Barr et al. also disclose accepting a query and returning a single search results list having both text and multi-media

information (temporal document), and query server performs a relevance ranking on each of the textual documents and multi-media files identified by the search by generating a relevance score corresponding to each of the entries on the search result list, and this relevance is based on the term location information contained in index database, and in part on the relative proximity within the document file of terms forming the search query (col. 12, lines 54-65, col. 13, lines 30-67 and col. 24, lines 19-26).

21. Applicant's arguments filed 06/19/2006 have been fully considered but they are not persuasive. Please see the rejection and response to arguments above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (571) 272-4092. The examiner can normally be reached on 8:30 am – 5:30 pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. On July 15, 2005, the Central Facsimile (FAX) Number will change from 703-872-9306 to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau Nguyen
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WILLIAM BASHORE
PRIMARY EXAMINER